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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/964,143

Filing Date: September 25, 2001

Appellant(s): MCLAUGHLIN, JAMES HUGH

Kenneth L. Cage
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 3, 2008 appealing from the Office action mailed April 12, 2008.

(1) (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal 2006-3210 for this application

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent 4,673,526	Zabotto et al.	June 16, 1987
US Patent 5,360,824	Barker	November 1, 1994
US Patent 6,042,815	Kellner et al.	March 28, 2000
US Patent 6,153,208	McAtee et al.	November 28, 2000
US Patent 6,197,281	Stewart et al.	March 6, 2001
US Patent 5,888,951	Ggnebien et al.	March 30, 1999
US Patent 5,891,449	Daniel et al.	April 6, 1999
US Patent 4,992,476	Geria	February 12, 1991

(9) Grounds of Rejection

1. Claims 44-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zabotto et al. (US 4,673,526), and Barker et al. (US 5,360,824, of record) in view of Kellner (US 6,042,815, of record), McAtee et al. (US 6,153,208, of record), Stewart et al. (US 6,197,281), Geria (US 4,992,476), Daniel et al. (US 5,891,449), and Gagnebien et al. (US 5,888,951).
2. Zobotto et al. teaches an anhydrous cosmetic composition for deep cleansing of skins comprising about 50-95 % of oily phase, about 1-30 % of emulsifying agent (surfactant), and about 1-10% of particulate abrasive agents. The composition is preferred in gel forms. See, particularly, col. 1, lines 7-20, line 66 to col. 2, line 12, and the claims. The oily phase comprising oils, which may be animal oil, vegetable oil, mineral oil, silicone oil or synthetic ester, of fatty acid, fatty alcohol, the oily phase may also comprising wax, which includes cetyl

alcohol, stearyl alcohol, and salt of fatty acids, such as calcium, magnesium and zinc salts of stearate, myristates, oleate, lanolate et al. See, particularly, col. 2, line 13 to col. 4, line 15.

Barker teaches skin cleansing composition comprising an oil phase with water soluble abrasive particulates suspended in the oil phase. sodium chloride particulates are disclosed as one of those particulate. See, particularly, the claims.

3. The primary references do not teach expressly the particular percentage of each and every ingredient herein claimed, or the employment of particular ingredients, such as particular abrasive agents, particular oil, calcium stearate, or the employment of sodium chloride, pumice, kernel starch as a particulate ingredients, and sodium cocoyl N-methyl taurate as the surfactant.

However, Kellner teaches water and oil emulsion solid cosmetic compositions. The composition comprising up to 30% of emollient oil, both natural and synthetic oil may be employed (see, particularly, col. 9, line 29 to col. 11, line 62. Kellner further discloses that addition emollient materials, such as fatty alcohol, wax, etc., as oil phase gelling agent may be employed up to 30% (see, particularly, col. 2, lines 66-67; col. 7, line 45 to col. 9, line 26). Kellner further teaches that up to 20 % of primary gelling agent may used, wherein the preferred primary gelling agent are salt of fatty acid, particularly, calcium stearate (see col. 2, lines 24-65). Surfactants up to 20% are desirable in the composition. Surfactants, including cationic, anionic nonionic and zwitterionic surfactants are suitable (see, col. 16, line 9 to col. 19, line 34). The composition may comprise up to 50% of particulate matter, the particulate matter may be organic or inorganic, such as corn starch, mica, etc. (see col. 19, lines 37-61). Stewart et al. teaches that polyvalent soaps, such as calcium stearate are well known to be useful as thickener fro making

oil-based gel. See, particularly, col. 9, lines 24-29. Geria et al. teaches that pumice is known to be useful as abrasive particles in cosmetic composition. See, particularly, col. 7, lines 25-40. McAtee disclosed that sodium cocoyl methyl taurate is similarly useful as other anionic surfactant in cleansing composition. (col. 20, lines 1-13). Daniel et al. teaches that kernel flour is known to be useful as abrasive agent in cleansing composition. Gagnebien et al. teaches that macadamia oil is known to be used in cleansing composition. See, particularly, col. 4, lines 35-40.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make a composition with the particular percentages of each and every components herein since the percentage range herein defined are either encompassed by, or overlapped with the range disclosed by the primary reference. Note it is well settled that in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Also see MPEP 2144.05. The employment of the particular ingredients such as kernel flour, sodium chloride, pumice, sodium N-cocoyl N-methyl taurate, macadamia oil and calcium stearate is obvious since all these ingredients are known to be useful in the cleansing composition. The employment of such components in the composition is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). The employment of sodium chloride is obvious because sodium chloride particulate is known to be useful in cleansing composition. The employment of calcium stearate is further obvious in view the fact that it is known to be useful as thickener in oil based composition.

(10) Response to Argument

4. The declarations under 37 CFR 1.132 filed December 31, 2007 and July 1, 2008 are insufficient to overcome the rejection of claims 44-59 based upon Zabotto et al. (US 4,673,526), Barker et al. (US 5,360,824, of record), Kellner (US 6,042,815, of record), McAtee et al. (US 6,153,208, of record), Stewart et al. (US 6,197,281), Geria (US 4,992,476), Daniel et al. (US 5,891,449), and Gagnebien et al. (US 5,888,951) as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. Particularly, the commercial product is composed of specific ingredients with specific amounts, claims herein encompass a variety of ingredients with a broad range of amounts for the ingredients. Claim 59 only requires some of the ingredients in the commercial product, not all the ingredients. Further, claim 59 lacks limitation of the amounts of the ingredients.
5. Furthermore, there is no prima facie case of a nexus between the commercial success and the claimed invention. Applicants assert a commercial success residing in claimed invention, but fail to. An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus.
6. Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. In re Tiffin, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines

was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. It is well established that commercial success must be derived from the claimed invention, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973). See, MPEP 716.03.

7. The declaration submitted July 1, 2008 fails to establish the sell is actually due to the invention, not other marketing factors.

8. In response to appellants’ arguments against the references individually, the examiner again maintains that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). *McAtee et al.* (US 6,153,208, of record), *Stewart et al.* (US 6,197,281), *Geria* (US 4,992,476), *Daniel et al.* (US 5,891,449), and *Gagnebien et al.* (US 5,888,951) are cited to show that some of the particularly ingredients employed herein are known in the art for their intended function herein. The arguments that those references individually do not teach the claimed composition are not persuasive. The cited references as a whole teach that each and every ingredients employed herein is known in the art as useful in skin care product and is known to be used in combination with the others.

As the Supreme Court recently reiterated "the need for caution in granting a patent based on the combination of elements found in the prior art" (*KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007)), particularly where there is "no change in their respective functions" (id). In other words, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results" As shown by the cited references as a whole, all the elements are known in the prior art for their function, The claimed invention yield no more than what predicted by the prior art.

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion and motivation are found in the cited references and in the knowledge generally available to one of ordinary skill in the art. Applicants particularly argue that since Kellner teach a composition contains a significant amount of water and is in solid form, so there is no motivation to combine Kellner with Zabotto et al and Barker, which teach anhydrous composition. The Arguments are not persuasive. All the references teach skin care products. All the references teach the usefulness of emollient, surfactant, and fatty acid salt in skin care products. It is particularly noted that Zabotto et al. teach fatty acid salts herein. Zabotto et al. Do not teach expressly the amount, or function of the fatty acid salts. Kellner et al. teach the function of the fatty acids salts and a broad range of amounts of the salts. Therefore, it would

have been obvious to one of ordinary skill in the art to employ fatty acid salt, as well as other known skin care ingredients herein in the amounts known in the art for making a skin care composition.

With respect to particulate abrasive, appellants argue that

The particulate abrasives of Zabotto are described as "hydrosoluble," but are not disclosed to be mildly abrasive, but non-irritating - a limitation required by base claim 44.

The examiner contends that the functional limitations "mildly abrasive, none irritating" would have been within the purview of ordinary skill in the art. Who would want a "none mildly, irritating" ingredient in a skin care product.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are on the record of this application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Shengjun Wang/

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